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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,098	09/04/2003	Hiroshi Kita	990788D2/HG	9919
1933 7590 01/22/2007 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			EXAMINER YAMNITZKY, MARIE ROSE	
			ART UNIT	PAPER NUMBER
			1774	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/656,098

Applicant(s)

KITA ET AL.

Examiner

Marie R. Yamnitzky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

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1. This Office action is in response to the request for reconsideration filed November 17, 2006.

Claims 1-13 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Inoue et al. (US 5,635,308) for reasons of record in the Office action mailed September 01, 2005.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al. (US 5,635,308) for reasons of record in the Office action mailed September 01, 2005.

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6. Claims 2-7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 5,717,289) in view of Inoue et al. (US 5,635,308) for reasons of record in the Office action mailed September 01, 2005.

7. Claims 8-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al. (US 5,635,308) in view of JP 10-025472 for reasons of record in the Office action mailed September 01, 2005.

8. Applicant's arguments filed November 17, 2006 have been fully considered but they are not persuasive.

Applicant argues that a 9,9'-bianthracene-10-yl group is a biaryl group giving an internal rotational isomerism because a 9,9'-bianthracene-10-yl group and its mirror image are not superimposable whereas a 9,9'-bianthracene-10,10'-diyl group is not a biaryl group giving an internal rotational isomerism because a 9,9'-bianthracene-10,10'-diyl group and its mirror image are superimposable. Applicant illustrates with A1/A1' and A2/A2' as shown on page 5 of applicant's response.

It appears to the examiner that applicant considers the images A1 and A1' to not be superimposable because the planar arrangement of the first anthracene ring in A1 is different than the planar arrangement of the first anthracene ring in the A1' structure shown in parentheses, whereas in A2 and the A2' structure shown in parentheses, the first anthracene ring has the same planar arrangement. (If there is any other difference, it is not clear to the examiner.) This

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presumes that the first anthracene ring in A1, A2 and the structures shown in parentheses are not at a 90° angle to the plane of the second anthracene ring in A1, A2 and the structures shown in parentheses. If the first and second anthracene rings are at 90° angles to each other, the images are superimposable regardless of how the planar arrangement is depicted on paper. It is also not clear to the examiner why the first anthracene ring in the structure shown in parentheses for A2' would not have the same planar arrangement as the first anthracene ring in the structure shown in parentheses for A1'.

To the extent that applicant's arguments may imply that the additional substituent that is bonded to a 9,9'-bianthracene-10,10'-diyl, but not bonded to a 9,9'-bianthracene-10-yl group, results in formation of a biaryl group that does not have a bond capable of giving an internal rotational isomerism, the examiner notes that the 9,9'-bianthracene structure shown on page 25 of the present specification may be a 9,9'-bianthracene-10,10'-diyl group. As taught on page 24 of the specification, one hydrogen is removed from each of the structures shown on page 25 to form the biaryl group, and there may be further substituents (i.e. further hydrogens may be removed). There is no limitation placed on the location of further substituents.

It is the examiner's position that applicant's arguments do not clearly patentably distinguish the present claims over the prior art, and the argument that a 9,9'-bianthracene-10-diyl group as in Inoue's Compound No. VII-21 is not a biaryl group having a bond giving an internal rotational isomerism is contrary to applicant's original disclosure.

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY
January 17, 2007



MARIE YAMNITZKY
PRIMARY EXAMINER

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